

Appln. No. 10/707,993
Docket No. 144213/GEM-0099

REMARKS / ARGUMENTS

Telephone Interview

Applicant thanks the Examiner for the courtesy of a telephone interview with Applicant's Attorneys/Agents on May 4th, 2007, regarding the restriction of Claim 16. In view of that conversation, Applicant has classified Claim 16 as "currently amended" rather than "withdrawn", and herein requests rejoinder of Claims 16-19. Claims 17-19 have been amended for consistency of language in the preamble.

Status of Claims

Claims 1-20 are pending in the application. Claims 1-9 and 20 stand rejected. Claims 16-19 have been withdrawn by the Examiner with indication of reconsideration if appropriately amended, and have been amended by Applicant with request for rejoinder. Claims 10-15 are allowed. Applicant appreciates the Examiner's notation of the allowable claims. Applicant has amended Claims 1, 16-20, and has added new Claims 21 and 22, leaving Claims 1-22 for consideration upon entry of the present Amendment.

Applicant respectfully submits that the rejections under 35 U.S.C. §102(b) have been traversed, that no new matter has been entered, and that the application is in condition for allowance.

Restriction Requirement

The Examiner remarks that the traversal is not persuasive because no claims are considered generic.

Applicant respectfully submits that Independent Claim 20 is a genus linking claim that performs the method of Claim 1 and requires the particulars of the device of Claim 16.

Upon allowance of the elected invention, should any linking claims be allowable, the restriction requirement between the linked inventions must be withdrawn from, and any claim directed to the non-elected invention, previously withdrawn from

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consideration, which depends from or requires all the limitations of the allowable linking claim must be rejoined and fully examined for patentability. MPEP §809

In view of the foregoing and the amendments made herein, Applicant submits that Claim 20 is allowable, and as a result, Claim 16 and claims dependent therefrom are herein requested to be rejoined.

Regarding Claim 16

The Examiner remarks "If Applicant were to include the pacemaker in claim 16, the examiner would reconsider the restriction." [paper 20070206, page 2]

Following the May 4th telephone interview, Applicant has amended Claim 16 to now include the recitation of the cardiac image acquisition device. No new matter has been added, as antecedent support may be found in the application as originally filed, such as originally filed Claim 16, and paragraph [0018], for example.

Apparatus Claim 16 now recites language that more closely correlates with allowed method Claim 10, which Applicant respectfully submits is more than sufficient for rejoinder of Claim 16, and requests rejoinder thereof.

Accordingly, Applicant respectfully requests reconsideration of the restriction requirement, and reinstatement and allowance of Claims 16-19.

Rejections Under 35 U.S.C. §102(b)

Claims 1-9 and 20 stand rejected under 35 U.S.C. §102(b) as being anticipated by Duggan (U.S. Patent No. 4,958,632, hereinafter Duggan).

Applicant traverses this rejection for the following reasons.

Applicant respectfully submits that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, *in a single prior art reference.*" *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). Moreover, "[t]he identical invention must be shown in as complete detail as is contained in the *** claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir.

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1989). Furthermore, the single source must disclose all of the claimed elements "arranged as in the claim." Structural Rubber Prods. Co. v. Park Rubber Co., 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984). Missing elements may not be supplied by the knowledge of one skilled in the art or the disclosure of another reference. Titanium Metals Corp. v. Banner, 778 F.2d 775, 780, 227 U.S.P.Q. 773, 777 (Fed. Cir. 1985).

Dependent claims inherit all of the limitations of the respective parent claim.

Regarding Independent Claim 1

Applicant has cancelled Claim 2 and has incorporated limitations therein into Claim 1 to now recite, inter alia, "...acquiring a cardiac image of the patient's fixed asynchronously paced heart...".

No new matter has been added by these amendments as antecedent support may be found in the specification as originally filed, such as at originally filed Claim 2 for example.

To allege anticipation of Claims 1-9 and 20 by Duggan, the Examiner states that the device also generates ECG images on an electrocardiograph. [Paper 20070206, page 2]

Applicant finds Duggan to disclose "Further, it is desired to transmit from the patient's body a variety of signals indicative of various conditions to be sensed and transmitted by the coil 16 and the transmitter 10 to be displayed upon the monitor 63." (emphasis added) [Duggan, col. 7, lines 57-61].

In comparing Duggan with the claimed invention, Applicant respectfully submits that Duggan discloses the display of signals (or waveforms), that have been provided via the pacemaker as shown upon the monitor (item 63) in Figure 1 of Duggan, but is absent disclosure of the claimed "...acquiring a cardiac image of the patient's fixed asynchronously paced heart...". Applicant respectfully submits that *an image of a heart* is substantially different from *a display of a pacemaker signal*.

Accordingly, Applicant submits that Duggan does not disclose each and every element of the claimed invention arranged as in the claim, and absent anticipatory

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disclosure in Duggan of each and every element of the claimed invention arranged as claimed, Duggan cannot be anticipatory.

Regarding Claim 4 More Specifically

Claim 4 recites "...wherein the signal injection device is *a magnetic signal injection device comprising at least one of a fixed magnet and an electromagnet.*"

In comparing Duggan with the claimed invention, Applicant finds Duggan to disclose and teach "an external transmitter 10 coupled by a lead 15 to a coil or antenna 16 disposed externally of the patient's body 14, *for transmitting RF coupled signals* to the internally implanted pacemaker 12." Col. 7, lines 40-43.

Here, Applicant finds Duggan to disclose *an RF signal injection device*, and not *a magnetic signal injection device comprising at least one of a fixed magnet and an electromagnet.*

Accordingly, Applicant submits that Duggan fails to disclose each and every element of the claimed invention arranged as claimed, and therefore cannot be anticipatory.

Regarding Claims 6 and 7 More Specifically

Claim 6 recites "...wherein *the magnetic signal injection device* is adapted to produce *a magnetic signal having a signal strength at the pacer equal to or greater than about 90 Gauss.*"

Claim 7 recites "...wherein *the magnetic signal injection device* produces *a magnetic signal having a signal strength at the pacer equal to or greater than about 90 Gauss when placed at a distance equal to or less than about 2 inches from the pacer.*"

In alleging anticipation of Claims 6 and 7, the Examiner does not recite where in Duggan each and every element of the claimed invention may be found, and in view of the remarks set forth above regarding Claim 4, Applicant finds Duggan to be deficient in disclosing each and every element of Claim 6. As such, Applicant respectfully submits that a prima facie case of anticipation has not been established.

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Regarding Independent Claim 20

Applicant has incorporated limitations from cancelled Claim 2 into Claim 20 to now recite, inter alia, "...acquiring a cardiac image of the patient's fixed asynchronously paced heart...".

No new matter has been added by these amendments as antecedent support may be found in the specification as originally filed, such as originally filed Claim 2 for example.

For at least the same reasons set forth above Regarding Independent Claim 1, Applicant respectfully submits that Independent Claim 20 is now allowable.

Accordingly, Applicant submits that Duggan does not disclose each and every element of the claimed invention arranged as in the claim, and absent anticipatory disclosure in Duggan of each and every element of the claimed invention arranged as claimed, Duggan cannot be anticipatory.

In view of the foregoing amendments and remarks, Applicant submits that Duggan does not disclose each and every element of the claimed invention arranged as claimed and therefore cannot be anticipatory. Accordingly, Applicant respectfully submits that the Examiner's rejection under 35 U.S.C. §102(b) has been traversed, and requests that the Examiner reconsider and withdraw of this rejection.

Regarding New Claims 21 and 22

Applicant has added new Claim 21, which depends from Claim 1 to now claim originally disclosed but previously unclaimed subject matter. No new matter has been added as antecedent support may be found in the application as originally filed, such as at Paragraphs [0018-0020] for example.

In view of the amendment and remarks set forth above regarding the allowability of Claim 1, and in view of Duggan not disclosing 3D cardiac imaging, Applicant submits that new Claim 21 is directed to allowable subject matter and respectfully requests entry and notice of allowance thereof.

Applicant has added new Claim 22, which depends from Claim 16 to now claim

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originally disclosed but previously unclaimed subject matter. No new matter has been added as antecedent support may be found in the application as originally filed, such as at originally filed Claims 1, 10 and 16 for example.

In view of the amendment and remarks set forth above regarding the allowability of Claim 16, and in view of Duggan not disclosing the signal injection device in combination with the other Claim 22 elements, Applicant submits that new Claim 22 is directed to allowable subject matter and respectfully requests entry and notice of allowance thereof.

If a communication with Applicant's Attorneys would assist in advancing this case to allowance, the Examiner is cordially invited to contact the undersigned so that any such issues may be promptly resolved.

The Commissioner is hereby authorized to charge any additional fees that may be required for this amendment, or credit any overpayment, to Deposit Account No. 07-0845.

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In the event that an extension of time is required, or may be required in addition to that requested in a petition for extension of time, the Commissioner is requested to grant a petition for that extension of time that is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to the above-identified Deposit Account.

Respectfully submitted,

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